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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/879,870 | 06/13/2001 | William M. Appleman | 82,282 | 4961 |

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Naval Surface Warfare Center
Carderock Division Headquarters
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West Bethesda, MD 20817-5700

EXAMINER

MENON, KRISHNAN S

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,870

Applicant(s)

APPLEMAN ET AL.

Examiner

Krishnan S Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 2 and 3 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the phrases "... sealed chamber within the module housing through which the contaminate-laden fluid is conducted externally of the processing elements;to accommodate lateral withdrawal of the filtered fluid from the processing elements ..." reads as if the contaminate-laden fluid is circulated within the chamber that contains the processing elements, external to the processing elements, and the filtrate comes out laterally of the processing elements from the same side (within the chamber) where the contaminate laden fluid is circulating. How would the filtrate come out from the same side of the processing element or chamber where the contaminate-laden fluid is conducted? For examination, the examiner assumes the contaminated fluid is flowing internally through the processing elements along their length, and the filtrate is coming out laterally of the processing elements into the chamber that contains the processing elements.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 2 and 3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Funatsu (US 6,284,451).

Funatsu (451) teaches a module with housing enclosing a plurality of elongated processing elements (hollow-fibers) (fig 1), sealing means for establishing a sealed chamber within the module housing (4), holding means for positioning the elongated elements within the sealed chamber in a bundled condition (2, fig 1), spacer means for maintaining the elements laterally spaced (3, fig 1) and drain for discharge of clean fluid (6, fig 1) as in claim 2. Contaminate-laden fluid could be conducted through the elements and filtrate collected laterally of the elements as in claim 2. A pair of axially spaced seal rings (4, fig 1) in radial sealing contact with housing, and the holding means retained within the seal ring for anchoring therein opposite ends of the elements in the bundled condition(3,4, fig 1) as in claim 3. Claims 2 and 3 are anticipated by, or in the least, obvious over the reference as best understood under the preceding 35 USC 112, 2nd paragraph, indefiniteness.

2. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Garcera et al (US 5,916,440).

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Garcera (440) teaches a module with housing enclosing a plurality of elongated processing elements (ceramic elements) (fig 1), sealing means for establishing a sealed chamber within the module housing (25), holding means for positioning the elongated elements within the sealed chamber in a bundled condition (see fig 1), spacer means for maintaining the elements laterally spaced (24, fig 1) and drain for discharge of clean fluid (4, fig 1) as in claim 2. Contaminate-laden fluid is conducted through the elements and filtrate collected laterally of the elements as in claim 2 (see arrow 3 fig 1). A pair of axially spaced seal rings (25, fig 1) in radial sealing contact with housing, and the holding means retained within the seal ring for anchoring therein opposite ends of the elements in the bundled condition (see 21 fig 1) as in claim 3. Claims 2 and 3 are anticipated by, or in the least, obvious over the reference as best understood under the preceding 35 USC 112, 2nd paragraph, indefiniteness.

Response to Arguments

Applicant's arguments filed on 5/15/03 have been fully considered but they are not persuasive.

Argument re drain port 6 of Funatsu: Claims are for an apparatus (combination of filter and housing). Funatsu teaches an apparatus as claimed. The intended function of the port 6 in Funatsu is not germane to the claim, because: "While features of an apparatus may be recited either structurally or functionally, claims <directed to >an <apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); <In re Danly, 263 F.2d 844, 847, 120

USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). The same is true for the argument re no lateral withdrawal of filtrate in *Funatsu*.

Argument, "...previously pointed out and never contested by the Examiner, ... Garcera patent do not filter fluid that is laterally withdrawn and discharged by drainage from the housing ...": Once again, claims are for the structure, what the filter does is function. Having said that, the applicant's attention is drawn to col 5 line 44 – col 6 line 36, particularly, col 5 lines 52-54 and col 5 line 65 – col 6 line 7. Contaminate-laden fluid would flow through the tubular channels (2) as shown by arrow 3, and filtrate would come out laterally of the elements (1) and out through the port as shown by arrow 4.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon
Patent Examiner
July 1, 2003


W. L. WALKER
SUPERVISORY PATENT EXAMINER
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